

REMARKS

By this amendment, Applicants make minor amendments to claims 1, 19, and 20. Claims 1-22 are thus now pending in the present application. Applicants appreciate the Examiner's thorough review and examination of the application in the Office Action dated March 27, 2007 and acknowledge with appreciation that the Examiner has withdrawn the restriction requirement. Applicants further respectfully submit that all pending claims are in condition for allowance for reasons as set forth below.

35 U.S.C. § 112 Rejections

In response to the rejection under 35 U.S.C. § 112 against claims 1-18, claim 1 has been amended so that the base consists essentially of magnesium bicarbonate, potassium carbonate, cesium carbonate, potassium phosphate, sodium hydroxide, and potassium hydroxide. Thus, claim 1, as amended, enables a person skilled in the art to make the invention commensurate in scope with claim 1. Furthermore, claims 2-18 depend from claim 1, so they are also currently enabling for a base. Meanwhile, claims 5-6 has been amended to depend from claim 2 to overcome any antecedent and indefiniteness issues.

35 U.S.C. § 102 and § 103 Rejections

The Examiner initially rejected claims 1, 2, 7, 8, and 19 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 as anticipated by and obvious over U.S. Patent No. 6,335,463 issued to Sommer (the '463 Patent). The Examiner then rejected claims 1-22 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,395,939 issued to Marcoux et al. (the '939 Patent). The Examiner finally rejected claims 1-22 under 35 U.S.C. § 103 as

being obvious over the '939 Patent and further in view of U.S. Patent Publication No. 2005/0,101,788 issued to Zanon et al. (the '788 Publication). Applicant respectfully disagrees with the Examiner's rationale for the §102 and §103 rejections and submits that the pending claims do not anticipate nor are they obvious over the cited references for the reasons as set forth below.

Starting with the '463 Patent. Sommer discloses a method for preparing the compound 1-[2-[4-[5-chloro-1-(4-fluorophenyl)-1-H-indol-3-yl]-1-piperidiny]ethyl]-2-imidazolidinone. However, the reference does not mention the presence of a ligand chelating the copper catalyst. Of course, for a § 102 rejection to stand, the cited prior art reference must disclose each and every limitation found in a claim against which it is cited. See *Verd gall Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("[A] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."); MPEP §2131 (emphasis added). Because Sommer does not teach the use of a ligand, claims 1, 2, 7, 8, and 19 20 are novel over Sommer. Accordingly, Applicant submits that the Examiner's rejection to the claims on the basis of this reference, insofar as applied to the claims as amended, is respectfully traversed and should be withdrawn.

Moving on to the '939 Patent, Marcoux et al. relates to an arylation between an aromatic compound ArX and a nucleophile Ar'YH in the presence of a base and a copper catalyst. However, Marcoux et al. does not disclose the presence of a ligand, a base, or water as the solvent, as the Examiner correctly stated in Paragraph 30 of the

Office Action dated March 27, 2007. In this case, Marcoux also fails to teach each and every element and limitation of claims 1-22, so Marcoux et al. does not anticipate claims 1-22. Accordingly, Applicant submits that the Examiner's rejection to the claims on the basis of this reference, insofar as applied to the claims as amended, is respectfully traversed and should be withdrawn.

Similarly, in the '788 Publication, there is no anticipation by the present application. Zannon et al. relates to the manufacture of 5-chloro-1-(4-fluorophenyl)-indole. In some examples, the solvent of the reaction contains water and organic solvents. However, the reaction mixture does not consist essentially of reactants, copper catalyst, base, and water. Therefore, amended claims 1, 19, and 20 are novel over Zannon et al.

Furthermore, the elements missing from the '939 Patent are not cured by the addition of the '788 or the '463 Patents, so the present application is not made obvious by the '939, '788, and '463 Patents based on the reasons as set forth follow.

Claims 1-22 are not obvious over the cited references for the following reasons. The reaction as claimed in the present application enables a better yield in less time, compared with known methods. More specifically, Zanon et al. discloses in examples 19, 20, and 27, a reaction time of 36, 40, and 19 hours, respectively, and a conversion rate of 89%, 67%, and 58%, respectively. Contrary to the low conversion rates taught in Zanon et al., example 1 of the instant application shows a conversion rate of the compound of over 90% after only 4 hours reaction time.

Additionally, none of the other cited references suggest using only water as the

solvent to improve the conversion rate and to reduce the reaction time. In fact, Zanon et al. teaches away from the present invention since examples 25 and 28 indicate better results in the absence of water. Thus, the skilled person would have no motivation to include more water or to even use water exclusively as the solvent for the reaction. Therefore, the invention as claimed is not obvious over the combined teaching of Marcoux in view of Zanon et al. and Sommer.

For the reasons set forth above, Applicant respectfully submits that the rejection of the claims of the present application as being obvious in view of a combination of the Marcoux, Zanon et al. and Sommer references is respectfully traversed and should be withdrawn. Accordingly, Applicant requests allowance of all claims now pending in the present application.

Thus, Applicant respectfully submits that the pending claims overcome all of the Examiner's rejections and have been placed in condition for immediate allowance. Having fully responded to the rejections set forth in the Office Action dated March 27, 2007, Applicant respectfully requests allowance of all claims now pending in the present application.

Respectfully submitted,

Date: July 27, 2007


By: B. Aaron Schulman
Registration No.: 31,877

STITES & HARBISON PLC ♦ 1199 North Fairfax St. ♦ Suite 900 ♦ Alexandria, VA 22314
TEL: 703-739-4900 ♦ FAX: 703-739-9577 ♦ CUSTOMER No. 000881